

REMARKS

The outstanding Office Action addresses claims 1, 3-15, and 37. Applicants appreciate the Examiner's indication that claims 7-15 represent allowable subject matter and that these claims would be allowed if rewritten in independent form. Applicants continue to submit, however, that independent claims 1 and 37 represent allowable subject matter, and reconsideration and allowance thereof is respectfully requested.

Amendments to the Claims

Applicants amend independent claims 1 and 37 to clarify that the tissue penetrating claws are configured to penetrate tissue while moving from the open position to the closed position. Support for this amendment can be found throughout the specification and in the drawings, for example, in Figures 2A-2C and 4A-4C. No new matter is added.

Rejections Pursuant to 35 U.S.C. §102(b)

The Examiner maintains the rejection of claims 1, 3-4, 6, and 37 pursuant to 35 U.S.C. §102(b) as being anticipated by Blake. In response to Applicants arguments that Blake does not disclose tissue *penetrating* claws, the Examiner argues that "how a structure is used is irrelevant because the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations." (Office Action, Page 3).

Amended claims 1 and 37 now recite tissue penetrating claws that are *configured to penetrate tissue while moving from the open position to the closed position*. Such a limitation requires that the claws have a certain structure that allows them to penetrate and engage tissue. As shown in FIGS. 2A-2C and 4A-4C of the present invention, for example, the claws are directed toward one another, thus when they are moved from the open position to the closed position they penetrate into tissue. Accordingly, the manner in which the device is intended to be employed does differentiate the claimed apparatus from the prior art. The claws of the Blake

device cannot penetrate tissue as they move from an open position to a closed position. Referring to Figure 1 of Blake, each claw 26, 26 has a substantially elongate shape with a pointed nose 20. While the claws 26, 26 are not intended to penetrate tissue, the only position in which the claws could penetrate tissue is the closed position, as illustrated. The claws of the Blake device cannot penetrate tissue *while moving from an open position to a closed position*, as required by claims 1 and 37 of the present invention. The claws do not have a structure that allows them to perform the recited function.

Accordingly, claims 1 and 37 are not anticipated by Blake and represent allowable subject matter. Claims 3-6 are allowable at least because they depend from an allowable base claim.

Applicants note that the present invention is particularly advantageous because it allows a body organ to be easily, quickly, and safely grasped to manipulate and position the body organ as desired. The claws can merely be moved from an open position to a closed position to grasp tissue without the need for any additional steps. Since the claws extend toward one another to penetrate tissue as they are closed, the claws are effective to engage a sufficient amount of tissue to reduce the risk of tearing the tissue during manipulation and positioning of the body organ being engaged.

Rejections Pursuant to 35 U.S.C. §103(a)

The Examiner further rejects dependent claim 5 pursuant to 35 U.S.C. §103(a) as being obvious over Blake on the basis that “it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tissue grasping elements with a circular shape” (Office Action, Page 3.)

Claim 5 is allowable at least because it depends from allowable base claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the remarks above, Applicants submit that claims 1, 3-15, and 37 are in condition for allowance. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: April 14, 2004



Lisa J. Michaud
Reg. No. 44,238
Attorney for Applicants

NUTTER, McCLENNEN & FISH, LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02210-2604
Tel: (617)439-2550
Fax: (617)310-9550

1303449.1